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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,759	11/11/1999	GISELA MEIER	2368/098	9841

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EXAMINER

LAM, ANN Y

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/438,759

Applicant(s)

MEIER ET AL.

Examiner

Ann Y. Lam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-17 and 19-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Schaer, 5,782,760. Schaer discloses an electrically conductive cannula tube (11 and 51), see Figure 13, with a tip (53), with an exit opening (34), the body part including an inlet opening axially aligned with the cannula tube, see Figure 1, a connector (22, 16, 17 and 18) electrically connected to the cannula in the area of the body part, wherein said cannula tube has an electrically insulating outer covering of the cannula tube, which extends from the body part out to the tip and which leaves the tip exposed at least in its distal end area, see column 3, lines 27-37, and wherein said electrical connector (22, 16, 17 and 18) extends through the body part to the outer surface of the cannula tube.

As to claim 13, an electrical connection is formed between the electrical connector (22, 16, 17 and 18) and cannula tube by an electrical contact pressed against the circumference of the cannula tube, to which contact a wire of a multi-strand connector (22) is soldered, see column 5, lines 14-18.

As to claim 14, the wire lies axially parallel against the cannula tube and the multi-strand conductor runs radially through the body part towards the outside.

As to claim 15, the proximal end of the cannula tube is provided co-axially in the body part, wherein a ring gap is formed between the proximal end of the cannula tube and the thereto connected electrically contacting connector (22, 16, 17 and 18) and an inner wall of the body part, and wherein said ring gap is filled with plastic, see column 5, lines 16-18, and column 7, lines 57-65.

As to claim 16, the inlet opening decreases in diameter to form an inlet funnel, see proximal end of cannula in Figure 1.

As to claim 17, the proximal end of the body part is a luer-lock connection, see proximal end of cannula in Figure 1.

As to claims 19 and 24, the distal tip is a facet cut, see distal tip of cannula in Figure 13 or alternatively Figure 15.

As to claim 20, the facet cut is angled at an angle of approximately 45 degrees to the axis of the cannula tube, see distal tip of cannula in Figure 13.

As to claim 21, the distal tip is formed as a closed conically arched tip with an exit opening, see distal tip of cannula in Figure 13.

As to claim 22, a ramp is formed on the inside of the distal end of the cannula tube, see distal tip of cannula in Figure 13, near reference number 53.

As to claim 25, said cannula tube tip is considered to be a Sprout tip.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schaer, 5,782,760. Schaer discloses the invention substantially as claimed, see above. However, Schaer does not disclose that the exposed end area of the distal tip of the cannula has a length of maximally 1mm.

Schaer however does disclose that a plastic jacket may be disposed about the distal shaft section and holes may be made in the jacket to expose small portions of the underlying electrodes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide holes as taught by Schaer having a maximum of 1 mm, as a particular size suitable for a medical treatment of a patient.

***Response to Arguments***

Applicant's arguments filed May 20, 2002, have been fully considered but they are not persuasive. Applicant argues that Schaer teaches a blunt tip electrode, see page 8, lines 2-3, and that the distal tip is not designed for or capable of use for piercing tissue, see page 8, lines 22-23, and that the Schaer device also differs in function from the present invention, see page 8, lines 29-31. In response, Examiner reasserts that the limitations as claimed are disclosed by Schaer, even if the function of the Schaer

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device is different from the present invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is (703) 306-5560. The examiner can normally be reached on T-F 8-6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on (703)308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

  
A.L.  
August 12, 2002

  
ANH TUAN T. NGUYEN  
PRIMARY EXAMINER  
8/12/02